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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
| 097283,596 | 04/10/99 | CARPENTIER | APPROPRIATE |

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|-------------|
| EXAMINER |
| REDDING, D. |

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| ART UNIT | PAPER NUMBER |
| 1744 | |

DATE MAILED: 05/03/04

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/283,596

Applicant(s)

CARPENTIER ET AL.

Examiner

David A Redding

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1-2.
- 17) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-31 are rejected under the judicially created doctrine of double patenting over claims 1-22 of U. S. Patent No. 5,931,969 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

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Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States;

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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3. Claims 10,13-16, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by the 1996 Fisher Scientific product catalogue, page 914.

On page 914 of the reference there is shown a stirring hot-plate with a flask which is clearly capable of containing tissue treatment fluid. The hot-plate is capable of heating any fluid within the flask and stirring the fluid using a magnetic stirring rod controlled by a magnetic drive. The fact that the claims are directed to treatment of fixed biological tissue is considered to be intended use of the apparatus and of no patentable weight.

Dunk
4. Claims 1,4,7,8,10, ~~(3,20,23,25-27,30,31)~~, are rejected under 35 U.S.C. 102(e) as being clearly anticipated by USP 5,792,603 (Dunkelman et al.).

The Dunkelman patent discloses a device which can be used for preserving or culturing tissue. The device comprises a flow container 14 with respective inputs 28 and outputs 30, a supply of treatment fluid 10, a tissue mount 32.

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Further, the reference discloses that the treatment fluid can be temperature controlled (heated) to the temperature of the human body (see col. 3, lines 12-25).

5. Claims 10,11,20,23,24,25,30,31, are rejected under 35 U.S.C. 102(e) as being anticipated by USP 5,882,918 (Goffe).

Figures 1 and 10 illustrate a treatment device which comprises a container 28, means for causing movement of the container (figure 10a), and a heater 20 which provides convective heating to the contents of container 28. Figure 11 shows the limitations of claims 30,31.

6. *Martha* Claims 10-12,20,21 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 3,002,895 (Freedman). *material worked on*

Freedman discloses an incubator-shaker apparatus which comprises flasks 140 capable of containing treatment fluid, an orbital shaker device, and resistance heating means 94 for heating the contents of the flasks.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USP 5,773,285 discloses a tissue treatment device which includes a mesh screen as a tissue support.

8. Any inquiry concerning this communication should be directed to David A Redding at telephone number 703-308-3910.

David Reddy

DAVID A. REDDING
PRIMARY EXAMINER
GROUP 1300